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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,505	02/13/2004	Qiwei He	3075.NWN	8910

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Cynthia L. Foulke
NATIONAL STARCH AND CHEMICAL COMPANY
10 Finderne Avenue
Bridgewater, NJ 08807-0500

EXAMINER

MULLIS, JEFFREY C

ART UNIT PAPER NUMBER

1711

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/779,505	Applicant(s) HE ET AL.	
	Examiner Jeffrey C. Mullis	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-4 and 6-12 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is unclear in that it recites that the radial copolymer is part diblock despite the fact that a diblock copolymer is not a radial block copolymer as the term is normally used in the art nor as defined by the structure of claim 1. Furthermore it is not clear what the percentage of claim 3 is based on since this is unstated.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Lechat et al. (US2005/0020773).

The reference disclose an adhesive composition having 31 % total block copolymer which has about 50% radial block copolymer based on total block copolymer content and having SIB arms of molecular weight 80,125 molecular weight and 69 % tackifier. Note paragraphs 116-118 and the Table in paragraph 118. With re to claim 6, paragraph 116 discloses the presence of two arm radial (i.e. linear block copolymer) which could be viewed as styrene isoprene styrene. With re to claim 11, patentees block copolymers themselves would have at least some elastomeric properties given that diene polymers (as are present in the form of a block in the block copolymers of the reference) are generally elastomeric and articles containing labels such as bottles are generally disposed of after use the articles of the reference can be said to be disposable and elastic.

Claims 1-4 and 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Diehl et al. (US 5,292,819).

Diehl disclose applicants radial block copolymer compositions in Examples 1-4 of the Table in column 14. Note that waxes may be added at column 15, lines 55-62 and that the material may be used to produce diapers at the paragraph bridging columns 5 and 6. With re to claim 6 it is assumed that at least a very small amount of diarm coupled polymer would be produced by the process given the known inefficiency of coupling of lithium terminated living polymer chains.

Claims 1-4 and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kueppers (US 5,939,483).

Patentees disclose an adhesive composition having as much as 40 % of a block copolymer, compatible polymer, tackifier and wax. Note the abstract. The compatible polymers include the block copolymers of applicants' claim 6 at column 5, lines 30-36. The block copolymers include partially coupled radial copolymers of applicants molecular weight at column 4, lines 25-50.

No specific examples exist having all of applicants combination of materials. However, choice of such would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results given that patentees disclosure lies within the broad ambit of the claims, absent any showing of surprising or unexpected results.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/779,420. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the two sets of claims overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed 6-2-06 have been fully considered but they are not persuasive. Claim 1 explicitly requires that "n" be at least 3 and block copolymers which are diblock would have to have $n=1$. While applicants adhesive composition may contain diblock, the radial copolymer does not encompass diblocks.

With re to Lechat, "about 25%" encompasses 40% as about allows for some leeway. The arms in the block copolymers are formed by polymerization of styrene and dienes and are linear and coupling of the active chain end of two of such species would result in a linear polymer, not branched. Applicants appear to allege some ambiguity in the term "two arm" but there does not appear any other way of interpreting this phrase except for a polymer resulting from coupling two (linear) polymer chains together such as would result in a linear block copolymer. Applicants argue that the "two arm" material is referred to by Lechat as a radial polymer but applicants refer to their diblock copolymer in claim 3 as "radial" also. Patentees make article with their composition and the diene blocks of patentees are elastomeric and hence any article containing the block

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copolymers of the a t relied upon can be said to be "elastic". Unpatented claims are given their broadest reasonable interpretation. Applicants amounts are disclosed in paragraph 118 of Lechat.

With re to Diehl, applicants admit in their remarks pertaining to the rejection under 35 USC 112, second paragraph that diblock copolymer (a linear polymer) is produced as a product in radial block copolymer production due to inefficient coupling.

With re to Kueppers applicants composition can be arrived at by selecting from the disclosure of patentees as set out above. Applicants styrene contents are disclosed at column 4, line 49.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
J Mullis
Art Unit 1711

JCM

7-10-06

Jeffrey Mullis
Primary Examiner
Art Unit 1711

A handwritten signature in black ink, appearing to be 'JCM', located below the printed name and title of Jeffrey Mullis.